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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,631	08/06/2003	Francis Zilka	ZILKP012US	1630

27949 7590 06/03/2004

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EXAMINER	
BEHREND, HARVEY E	

ART UNIT	PAPER NUMBER
3641	

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/604,631	ZILKA ET AL.	
	Examiner	Art Unit	
	Harvey E. Behrend	3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 3/10/04

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-130 is/are pending in the application.

4a) Of the above claim(s) 1-65 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 66-130 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 9/4/03 & 1/13/04
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Applicants election without traverse of Group II (claims 66-130) in the response filed 2/10/04 is acknowledged.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 66-130 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This application is stated on page 1 of the specification as being a continuation having an effective filing date of 1/17/97.

However, there is no proper support in the specification itself for all of the limitations set forth in present claims 66-130.

For example, there is no support in the original specification for stating that the tubular device is freely positioned into the hot heat-exchange device.

There is no support in the original specification for the references in claim 66 lines 10, and 12, 13 to the limitations of "non-destructively" and "substantially all explosive impact is provided from said at least one explosive material".

There is no support in the original specification for the recitation in claims such as claim 130, of using only some of the coolant (note the phrase "at least some coolant").

4. Claims 66-130 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague, indefinite and incomplete, particularly as to what all is meant by and is encompassed by the recitation of "tubular device freely positioned into the hot heat-exchange device".

In claim 66, it is not clear if the term "non-destructively" is to relate back to the step of cooling or, to the step of introducing. In any event, claim 66 is vague, indefinite and incomplete as to how and in what manner, the mere step of cooling (no degree of cooling being recited) and/or the mere step of introducing, results in the "non-destructive" feature.

Claim 66 is vague, indefinite and incomplete as to what all is meant by and is encompassed by the phrase "substantially all explosive impact is provided from said at least one explosive material".

Claim 66 is vague, indefinite and incomplete as to the relationship (if any) of the phrase "cooling, using a coolant" in line 8, to the phrase "using a coolant cooling" in lines 13, 14.

There is no proper antecedent basis for all terms present, note for example, the term "said at least some coolant" in claim 130 line 8.

Claims such as claim 130 are vague, indefinite and incomplete as to how and in what manner, only some of the introduced coolant is delivered to the explosive material.

5. Claims 66-130 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

There is no adequate description nor enabling disclosure of how and in what manner, the tubular device is "freely positioned" into the hot heat exchange device.

There is no adequate description nor enabling disclosure of what all is meant by and is encompassed by the references in claim 66 to "non-destructively" and "substantially all explosive impact is provided from said at least one explosive material".

There is no adequate description nor enabling disclosure of how and in what manner, only some of the introduced coolant is delivered to the explosive material (as recited in claim 130).

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 66-130 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by VBB publication number 5410708 (cited by applicant).

The reference shows the actual claimed steps. It is noted that applicants specification on the bottom of page 1 states that boilers and furnaces are heat exchange devices.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 66-130 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-32 of U.S. Patent No. 6604468, claims 11-18 of U.S. Patent No. 6431073, claims 36-70 of U.S. Patent No. 6321690 and claims 12-21 of U.S. Patent No. 5769034. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ in scope only as to obvious variants such as, not damaging the heat-exchange device, mode of coolant flow, etc.

11. The reference GB 823353 (cited by applicant in an IDS) has not been considered as a copy thereof could not be located in the files of the parent applications.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harvey Behrend whose telephone number is (703) 305-1831. The examiner can normally be reached on Tuesday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

HARVEY E. BEHREND
PRIMARY EXAMINER